

1 Leo R. Beus (*pro hac vice*)
2 L. Richard Williams (*pro hac vice*)
3 K. Reed Willis (*pro hac vice*)

4 **BEUS GILBERT PLLC**

5 ATTORNEYS AT LAW

6 701 NORTH 44TH STREET
7 PHOENIX, ARIZONA 85008-6504
8 TELEPHONE: (480) 429-3000

9 E-mail: lbeus@beusgilbert.com
10 rwilliams@beusgilbert.com
11 rwillis@beusgilbert.com

12 Allan Steyer (State Bar No. 100318)
13 Donald Scott Macrae (State Bar No. 104663)
14 Jill K. Cohoe (State Bar No. 296844)

15 **STEYER LOWENTHAL BOODROOKAS**

16 **ALVAREZ & SMITH LLP**

17 235 Pine Street, 15th Floor
18 San Francisco, California 94104
19 Telephone: (415) 421-3400
20 Facsimile: (415) 421-2234
21 E-mail: asteyer@steyerlaw.com
smacrae@steyerlaw.com
jcohoe@steyerlaw.com

22 *Attorneys for Plaintiff Nikola Corporation*

23 [Additional Counsel on Signature Page]

24 **UNITED STATES DISTRICT COURT**

25 **NORTHERN DISTRICT OF CALIFORNIA**

26 **SAN FRANCISCO DIVISION**

27 Nikola Corporation, a Delaware
28 corporation,

Plaintiff,

vs.

Tesla, Inc., a Delaware corporation,

Defendant.

Case No.: 3:18-CV-07460-JD

**JOINT CASE MANAGEMENT
STATEMENT**

Date: October 29, 2020

Time: 10:00 a.m.

Courtroom: 11, 19th Floor

Judge: Honorable James Donato

1 Pursuant to the Order Setting Rule 16 Case Management Conference (Dkt. 127), the
 2 Standing Order for All Judges of the Northern District of California, dated January 17, 2017,
 3 Local Patent Rule 2-1, and Civil Local Rule 16-9, the parties submit the following Joint Case
 4 Management Statement.

5 **1. Jurisdiction and Service.**

6 This case arises under the Patent Act of the United States of America, 35 U.S.C. § 1 *et*
 7 *seq.* and the Lanham Act, 15 U.S.C. § 1051 *et seq.* This Court has jurisdiction over the
 8 Complaint pursuant to 28 U.S.C. §§ 1331, 1338, 2201, 2202, and 35 U.S.C. § 100.

9 All parties have been served, and neither party is contesting personal jurisdiction or
 10 venue.

11 **2. Facts.**

12 **Chronology:** This case involves allegations of design patent, utility patent, and trade
 13 dress infringement. Nikola alleges that it designed an alternative fuel semi-truck and filed six
 14 design patent applications on 30 December 2015. Nikola alleges that on 1 December 2016, it
 15 unveiled its prototype in Salt Lake City to a crowd of 600 journalists. On 30 December 2016,
 16 Nikola submitted a utility patent application.

17 On 28 April 2017, Tesla released a teaser photo of its semi-truck design. On 7
 18 November 2017, Nikola sent a letter to Tesla concerning Tesla's semi truck and what Nikola
 19 claimed to be potential intellectual property infringement. On 16 November 2017, Tesla
 20 unveiled its semi-truck in Hawthorne, California.

21 Between February and April 2018, the United States Patent and Trademark Office
 22 ("PTO") issued six design patents to Nikola. On 1 May 2018, Nikola filed suit against Tesla
 23 for patent infringement of three design patents (U.S. Patent No. D811,944; U.S. Patent No.
 24 D811,968; and U.S. Patent No. D816,004, collectively "design patents-in-suit"). On 18
 25 September 2018, the PTO issued Nikola a utility patent (U.S. Patent No. 10,077,084, "'084
 26 patent"). On 18 October 2018, Nikola filed its Third Amended Complaint alleging that Tesla
 27 infringed the design patents-in-suit, the '084 patent, and Nikola's alleged trade dress.

1 **Factual Issues in Dispute:** At this stage, the parties believe that the principal factual
2 issues in dispute include: one or more facts related to whether Tesla infringes any of Nikola's
3 asserted patents; one or more facts related to whether such patents are valid and enforceable;
4 one or more facts related to whether Nikola has protectable and enforceable trade dress rights
5 and, if so, whether Tesla infringes the alleged trade dress; and one or more facts related to
6 whether Nikola is entitled to damages or any other relief for any alleged infringement by Tesla
7 and, if so, the amount of any such damages.
8

9 This description should not be construed as an admission or adoption by any part of any
10 factual contention alleged by the other party. The parties reserve the right to revise or include
11 any other appropriate issues as they develop or become known to the parties through the course
12 of discovery and investigation.

13 **3. Legal Issues.**

14 Nikola asserts that Tesla infringes the design patents-in-suit, the '084 patent, and certain
15 alleged trade dress in Nikola's Nikola One truck. At this stage, the parties believe that the
16 principal legal issues in dispute include: the proper construction of the asserted claims of the
17 design patents-in-suit and the '084 patent; whether Tesla infringes any of the asserted claims
18 of the design patents-in-suit or the '084 patent; whether any of the asserted claims of the design
19 patents-in-suit or the '084 patent are invalid or unenforceable; whether Nikola's alleged trade
20 dress satisfies the legal requirements for protectable trade dress and, if so, whether Tesla
21 infringes the alleged trade dress; if Tesla is found liable for infringement of any valid and
22 enforceable claim of the design patents-in-suit, the '084 patent, or trade dress, the amount of
23 damages, if any, to which Nikola is entitled from Tesla; and whether either Nikola or Tesla is
24 entitled to attorneys' fees and costs, including pursuant to 35 U.S.C. § 285.

25 These legal issues are not intended to be final or exhaustive, and the parties reserve the
26 right to revise or include any other appropriate issues as they develop or become known to the
27 parties through the course of discovery and investigation.
28

1 **4. Motions**

2 *Plaintiff Nikola Corp.:*

3 Nikola anticipates filing the following motions:

4

5

6

7

8

- Motion for Summary Judgment: The motion will address Tesla's affirmative defenses; and
- Motions to Strike Experts: The motion will address any and all shortcomings in any expert used or report submitted by Tesla.

9 *Defendant Tesla, Inc.:*

10 Tesla may file one or more of the following motions:

11

12

13

14

15

16

- Motions for Summary Judgment: The motion(s) will address one or more of Nikola's claims for patent and trade dress infringement, Tesla's defenses, and any other defenses properly considered on summary judgment; and
- Motions to Strike or Otherwise Disqualify Experts: The motion(s) will address any and all shortcomings in any expert used or report submitted by Nikola.

17 **5. Amendment of Pleadings**

18 *Plaintiff Nikola Corp.:*

19 Nikola may seek leave of Court to amend the pleadings to add additional claims against Tesla based on pending patent applications. Nikola may also seek leave of Court to amend the pleadings or its infringement contentions based on any modification of Tesla's design. Nikola does not expect to add additional parties to the case.

20 *Defendant Tesla, Inc.:*

21 Tesla has answered the Third Amended Complaint.

22 Tesla does not expect to add additional parties to the case.

23

24

25

26

27

28

6. Evidence Preservation.

The parties certify that they have reviewed the Guidelines Relating to the Discovery of Electronically Stored Information ("ESI Guidelines"). The parties have met and conferred

1 regarding evidence preservation, and reasonable and proportionate steps taken to preserve
2 evidence.

3 **7. Disclosures.**

4 The parties served their initial disclosures on August 8, 2018 and produced documents
5 with their initial disclosures pursuant to the District of Arizona's Mandatory Initial Discovery
6 Pilot program.

7 **8. Discovery.**

8 The parties have produced some documents to each other in response to Mandatory
9 Initial Discovery Program in the District of Arizona, but anticipate additional documents being
10 produced. No other discovery has been taken. The parties ask the Court to adopt the following
11 discovery limitations: 25 interrogatories, including subparts, 50 requests for production,
12 including subparts, and 50 requests for admission, including subparts.

13 The parties agree that each side be allowed 10 depositions, with no deposition lasting
14 more than 7 hours. The parties further acknowledge that the Court allows one deposition
15 pursuant to Federal Rule of Civil Procedure 30(b)(6) with no more than 10 topics proposed for
16 the deposition.

17 The court in the District of Arizona entered a largely stipulated Protective Order (Dkt.
18 41), which includes provisions regarding assertions of privilege or work-product. The parties
19 ask that discovery materials in the case continue to be governed by that already-entered
20 Protective Order (Dkt. 41). With respect to paragraph 13 of the Protective Order ("Filing
21 Protected Material"), the parties understand that this Court's local rules and this Court's
22 Standing Order for Civil Cases before Judge James Donato govern the requirements for filing
23 any documents under seal.

24 **E-Discovery Order:** The parties will jointly submit any proposed modifications to the
25 Court's Standing Order for E-Discovery and Email Discovery in Patent Cases within 30 days
26 after the initial Case Management Conference.

27 **Discovery Plan:** The parties served their initial disclosures on August 8, 2018.

1 *Plaintiff Nikola Corp.:* Nikola will seek discovery from Tesla in the nature of e-mails,
 2 business records, marketing plans, design drawings, development documents of the Tesla
 3 Semi, technical documents, sales and accounting records, financial projections and other
 4 financial documents, either stored electronically or in paper form. Nikola will also seek
 5 discovery from Tesla regarding any design modifications made after the lawsuit. Nikola
 6 anticipates deposing relevant witnesses from Tesla, Inc. This discovery goes to the central
 7 issues of the case, Tesla's infringement of Nikola's patents and trade dress, and damages
 8 associated with such infringement. As alleged in the complaint, Nikola is seeking its lost
 9 profits and disgorgement of Tesla's profits. As such, the amount in controversy is quite large,
 10 estimated to be over \$2 billion. Tesla has greater access to this information than Nikola. In
 11 sum, the discovery sought by Nikola is proportional to the needs of the case.
 12

13 *Defendant Tesla, Inc.:* Tesla will seek discovery from Nikola in the nature of e-mails,
 14 business records, marketing plans and market statements, licensing documents and plans, the
 15 conception and reduction to practice of the claimed designs and inventions, the prosecution of
 16 the patents-in-suit, design drawings, development documents of the claimed designs, the
 17 Nikola One, and other Nikola products, technical documents, sales and accounting records,
 18 financial projections and other financial documents, documents that otherwise substantiate
 19 Nikola's damages claims, either stored electronically or in paper form. Tesla anticipates
 20 deposing relevant witnesses from Nikola Corporation, including the inventors of the patents-
 21 in-suit. Tesla will also seek discovery from third parties regarding prior art to the design
 22 patents-in-suit and the '084 patent, which will include documents and potential testimony.
 23 This discovery is relevant and proportional to Nikola's infringement and damages claims, as
 24 well as Tesla's defenses, including invalidity. Tesla will also seek additional discovery in
 25 connection with its counterclaims.
 26

27 Discovery should be completed by January 18, 2022. The parties do not believe
 28 discovery should be in phases or limited to particular issues.

1 The parties do not have any issues about disclosures, discovery, or preservation of
 2 electronically stored information.

3 The parties believe that an order under Federal Rule of Evidence 502(d) is warranted
 4 in this case and included it as a term in the Protective Order entered by the District of Arizona
 5 (Dkt. 41).

6 The parties do not have any discovery disputes at this time.

7 **9. Class Actions.**

8 This is not a class action case.

9 **10. Related Cases.**

10 Tesla filed an *inter partes* review petition challenging Nikola's U.S. Pat. No.
 11 10,077,084. On March 27, 2020, the United States Patent Trial and Appeal Board declined to
 12 institute proceedings. Doc. 123.

13 **11. Relief.**

14 *Nikola's Position:* Nikola is seeking damages from Tesla, at a minimum, as a
 15 reasonably royalty as determined by applicable law. Alternatively, Nikola may seek its lost
 16 profits as calculated under applicable law. Nikola is also seeking disgorgement of Tesla's
 17 profits under 35 U.S.C. § 289 or 15 U.S.C. § 1117, as determined by applicable law.
 18 Specifically, Nikola will base its damages on the revenue or profit that Tesla has gained or
 19 Nikola has lost because of Tesla's infringement of Nikola's design and utility patents and trade
 20 dress, minus any costs as allowed under applicable law. Lastly, Nikola will seek its attorney's
 21 fees and costs under applicable statutes, and other relief the Court deems appropriate
 22

23 *Tesla's Position:* Tesla denies that Nikola is entitled to any of its requested relief. Tesla
 24 asserts that Nikola's claims constitute an exceptional case under both 35 U.S.C. § 285 and 15
 25 U.S.C. § 1117(a) and, accordingly, requests the Court award Tesla costs and reasonable
 26 attorneys' fees incurred in connection with this action under this and any other applicable
 27 statutes, and such other relief as the Court deems just and proper.

1 **12. Settlement and ADR.**

2 The parties held a mediation before Magistrate Judge Corley, which did not result in a
3 settlement. Doc. 126.

4 The parties have complied with ADR Local Rule 3-5 and elected for a private
5 mediation. The parties believe that discovery necessary to position the parties to negotiate a
6 resolution may include discovery related to the development and design of the parties' vehicles
7 and intellectual property, relevant prior art to the design patents-in-suit and the '084 patent,
8 Nikola's infringement contentions, Tesla's invalidity contentions, and certain limited,
9 relevant, financial information of the parties. The parties also believe that any claim
10 construction order may help position the parties to negotiate a resolution.

11 **13. Consent to Magistrate Judge For All Purposes.**

12 The parties do not consent to have a magistrate judge conduct all further proceedings
13 including trial and entry of judgment.

14 **14. Other References.**

15 This case is not suitable for reference to binding arbitration, a special master, or the
16 Judicial Panel on Multidistrict Litigation.

17 **15. Narrowing of Issues.**

18 The parties believe that issues for trial may be narrowed through motions for summary
19 judgment. The parties do not request bifurcation of any issues, claims, or defenses.

20 **16. Expedited Trial Procedure.**

21 The parties agree that this case is not suitable to be handled under the Expedited Trial
22 Procedure of General Order No. 64.

23 **17. Scheduling.**

24 The parties propose the following schedule as set forth in Exhibit A.

25 **18. Trial.**

26 Both parties timely requested a jury trial with respect to all claims properly triable
27 before a jury.

1 The parties request a two-week trial, with 5 trial days each week.
2

3 **19. Disclosure of Non-party Interested Entities or Persons.**

4 The parties have filed or will have filed a Disclosure of Non-party Interested Entities
5 or Persons. (See Dkt. 78)

6 *Nikola*: Nikola states, pursuant to Civil L.R. 3-15, that as of this date, other than the
7 named parties, there is no such interest to report.

8 *Tesla*: Tesla states, pursuant to Civil L.R. 3-15, that as of this date, other than the named
9 parties, there is no such interest to report.

10 **20. Professional Conduct.**

11 All attorneys of record for the parties have reviewed the Guidelines for Professional
12 Conduct for the Northern District of California.

13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

1
2 DATED: October 22, 2020

3 Respectfully submitted,

4 By /s/ K. Reed Willis

5 K. Reed Willis

6 **BEUS GILBERT PLLC**

7 Leo R. Beus (Admitted *Pro Hac Vice*)

8 lbeus@beusgilbert.com

9 L. Richard Williams (Admitted *Pro Hac Vice*)

10 rwilliams@beusgilbert.com

11 K. Reed Willis (Admitted *Pro Hac Vice*)

12 rwillis@beusgilbert.com

13 701 North 44th Street

14 Phoenix, AZ 85008-6504

15 T: 480-429-3000 | F: 480-429-3001

16 **STEYER LOWENTHAL BOODROOKAS
17 ALVAREZ & SMITH LLP**

18 Allan Steyer (State Bar No. 100318)

19 asteyer@steyerlaw.com

20 Donald Scott Macrae (State Bar No. 104663)

21 smacrae@steyerlaw.com

22 Jill K. Cohoe (State Bar No. 296844)

23 jcohoe@steyerlaw.com

24 Attorneys for Plaintiff Nikola Corporation

25 By /s/ Michael K. Friedland

26 Michael K. Friedland

27 **KNOBBE MARTENS OLSON & BEAR LLP**

28 Michael K. Friedland

Lauren Keller Katzenellenbogen

Adam B. Powell

Kimberly A. Kennedy

Attorneys for Defendant
28 TESLA, INC.

1 **ATTESTATION**

2 I, Jill K. Cohoe, am the ECF user whose user *ID* and password authorized the filing of
3 this Document. Under Civil L.R. 5-1(i)(3), I attest that all signatories to this document have
4 concurred in this filing.

5 Dated: October 22, 2020

6 /s/ Jill K. Cohoe

7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

EXHIBIT A

MATTER	DEADLINE	PLAINTIFF(S) REQUEST	DEFENDANT(S) REQUEST
Disclosure of Asserted Claims and Infringement Contentions and Document Production Accompanying Disclosure (N.D. Patent L.R. 3-1(a)-(h) to 3-2(a)-(e)).	Scheduling Conference Date plus fourteen (14) days (N.D. Patent L.R. 3-1 and 3-2).		November 13, 2020
Last Day to File Motions to Add Parties and Amend Pleadings	Scheduling Conference Date plus sixty (60) days.		January 8, 2021
Disclosure of Invalidity Contentions and Production Accompanying Invalidity Contentions (N.D. Patent L.R. 3-3(a)-(d) to 3-4(a)-(b)).	Deadline for Infringement Contentions Disclosure plus forty-five (45) days (adapted from N.D. Patent L.R. 3-3).		January 15, 2021
Exchange of Proposed Terms for Construction (N.D. Patent L.R. 4- 1(a)-(b)).	Deadline for Invalidity Contentions Disclosure plus fourteen (14) days (N.D. Patent L.R. 4-1).		January 29, 2021
Exchange of Preliminary Claim Constructions and Extrinsic Evidence (N.D. Patent L.R. 4- 2(a)-(c)).	Exchange of Proposed Terms for Construction plus twenty-one (21) days (N.D. Patent L.R. 4-2).		February 26, 2021
Damages Contention	50 days after Invalidity Contentions (N.D. Patent L.R. 3-8)		March 5, 2021
Joint Claim Construction and Prehearing Statement (N.D. Patent L.R. 4-3(a)-(e)).	60 days after Invalidity Contentions.		March 19, 2021
Responsive Damages Contention	30 days after Damages Contention (N.D. Patent L.R. 3-9)		April 5, 2021
Completion of Claim Construction Discovery (N.D. Patent L.R. 4-4.)	30 days after Joint Claim Construction and Prehearing Statement		April 19, 2021
Opening Claim Construction Briefs	Deadline for filing of Joint Claim Construction and Prehearing Statement plus forty-five (45) days (N.D. Patent L.R. 4-5)		May 7, 2021
Responsive Claim Construction Briefs	Deadline for filing of Opening Claim Construction Briefs plus fourteen (14) days (N.D. Patent L.R. 4-5)		May 21, 2021

1	Reply Claim Construction Briefs	Deadline for filing of Responsive Claim Construction Briefs plus seven (7) days (N.D. Patent L.R. 4-5)	May 28, 2021
2	Technology Synopsis	7 days before technology tutorial	June 10, 2021
3	Technology Tutorial	One to two weeks before claim construction hearing	June 17, 2021
4	Claim Construction Hearing	As the Court's calendar permits	July 1, 2021
5	Claim Construction Ruling Date	At the Court's convenience	At the Court's convenience
6	Production Related to Reliance Upon Advice of Counsel (N.D. Patent L.R. 3-7(a)-(c).)	30 days after service of the Claim Construction Ruling.	Later of September 7, 2021 or 30 days after claim construction ruling
7	Subsequent Case Management Report	Judge Donato's Standing Order for Claim Construction	At the Court's convenience
8	Fact Discovery Cut-Off		October 22, 2021
9	Last Day to Serve Initial Expert Reports (unrelated to claim construction).		November 19, 2021
10	Last Day to Serve Rebuttal Expert Reports (unrelated to claim construction).		December 17, 2021
11	Last Day to Conduct Settlement Proceedings.		December 17, 2021
12	Expert Discovery Cut-Off.		January 28, 2022
13	Summary Judgment Opening Briefs		February 18, 2022
14	Summary Judgment Responsive Briefs		March 18, 2022
15	Summary Judgment Reply Briefs		April 1, 2022
16	Last Day to File <i>Daubert</i> Motions.		April 9, 2022
17	Last Day to Serve Motions in Limine	14 days before pre-trial filings	April 15, 2022
18			
19			
20			
21			
22			
23			
24			
25			
26			
27			
28			

1	Last Day to Serve Responses to Motions in Limine	4 days before pre-trial filings	April 22, 2022
2	Pre-trial Filings	14 days before final pre-trial conference	April 28, 2022
3	Last Day to Meet & Confer regarding Deposition Designations	21 days before the start of trial	May 9, 2022
4	Final Pre-Trial Conference (Thursdays at 1:30 p.m.)	19 days before the start of trial	May 12, 2022
5	Last Day to File Deposition Designations	5 days before the start of trial	May 25, 2022
6	Trial		May 30, 2022

CERTIFICATE OF SERVICE

I am a citizen of the United States, over the age of eighteen years, and not a party to the within action. I am employed in the County of San Francisco, State of California, and my business address is Steyer Lowenthal Boodrookas Alvarez & Smith LLP, 235 Pine Street, 15th Floor, San Francisco, California 94104.

On the date set forth below, I served a true and correct copy of the following document(s):

JOINT CASE MANAGEMENT STATEMENT

[x] By transmitting the above documents to the Clerk's Office using the CM/ECF System for filing and transmittal of a Notice of Electronic Filing to CM/ECF registrants.

I certify under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on October 22, 2020

Alma M. Caliz